

### **Remarks/Arguments**

The Examiner rejected claims 32-33 and 35 under 35 USC § 102(b) as being anticipated by Japanese Patent Specification No. 58-103565. The Examiner provisionally rejected claims 27-41 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-47 of copending Application No. 10/603,332. The Examiner rejected claims 27, 32, 35, 36 and 39 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Earlier the Examiner's indicated allowable subject matter in Claims 18-26 (see Office Action dated 6/9/05, page 5, paragraph 7). Based upon the Examiner's indication that Claims 18-26 would be allowable if re-written to independent claim form, the Applicant had canceled all claims without prejudice and introduced new claims 27-41 in their previous response. However, the Examiner has cited new art against claims 32-33 and 35 and rejected all claims that were rewritten as per the Examiner's advice.

The Applicant has amended claims 27, 32-33, and 35-39 and added new claims 42-45 to expedite the prosecution and place all the claims in allowable condition under 35 USC §§ 102 and 112. No new matter is added by this amendment. All the claims are in condition for allowance.

### **Arguments**

The Examiner has rejected claims 32-33 and 35 under 35 USC §102(b) as being anticipated by Japanese Patent Specification No. 58-103565, which is a new citation.

In order to establish proper anticipation under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The claimed elements either be inherent or disclosed expressly in the single prior art reference. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988) and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The absence from the reference of any claimed element necessarily negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 220 USPQ 81 (Fed. Cir. 1986).

The new citation, the ‘565 Application, discloses an “electroconductive paint comprises (1) electroconductive powder consisting of 10-70 wt. % Ag, 0.1-3 wt. % of Be and balance Cu, 2) resins, and 3) solvents.” Ag-Be-Cu alloy powder has granular diameter of 0.05-10 microns. The ‘565 Application further discloses that the treatment of the alloy powders with 1,2,3-benzotriazole dissolved in acetone improves anticorrosiveness. Claims 32-33 and 35, as amended, do not disclose any alloys. New claim 43 introduced in this amendment does not claim the specific Ag-Be-Cu alloy disclosed in the ‘565 Application. Accordingly, the Applicant respectfully submits that claims 32-33, 35 and 43 are not anticipated by the ‘565 Application and overcome the rejection under 35 USC 102(b).

Claims 27-41 have been provisionally rejected over copending U.S. Application No. 10/603,332 on the ground of non-statutory obviousness-type double patenting. The Applicant has filed a terminal disclaimer in compliance with 37 CFR 1.321(c) along with this response and, accordingly, respectfully submits that the rejection has been overcome.

Claims 27, 32, 35, 36 and 39 have been rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant has amended the claims 27, 32, 35, 36 and 39 to further clarify and comply with 35 USC § 112, second paragraph. Accordingly, the Applicant respectfully submits that claims 27, 32, 35, 36 and 39 are in condition for allowance.

New claim 42 covers the subject matter of the claims 27 and claims the mixtures comprising “short-chain acids”. The phrase “Short chain acids” or “short-chain fatty acids (SCFA)” is a general phrase well known in the literature and understood by an ordinary person of skill in the art to be fatty acids having less than 10 carbon atoms. Examples of such short-chain acids or short-chain fatty acids are: acetic acid (acetate), butyric acid (butyrate), glycolic acid (glycolate), mevalonic acid (mevalonate), propionic acid (propionate), pyruvic acid (pyruvate) etc. See for example, Medical Dictionary available on the Internet at:

[http://www.wrongdiagnosis.com/medical/short\\_chain\\_fatty\\_acid.htm](http://www.wrongdiagnosis.com/medical/short_chain_fatty_acid.htm). Accordingly, the Applicant respectfully submits that the phrase “short-chain acids” is well known and one

of ordinary skill in the art would understand and reasonably would be apprised of the scope of the invention.

Claim 44 claims the alloy steel, which was deleted from claim 39 to comply with 35 USC § 112, second paragraph. Accordingly, the Applicant respectfully submits that claim 44 is allowable.

Claim 45 incorporates the matter deleted from claim 32 to comply with 35 USC § 112, second paragraph. Accordingly, the Applicant respectfully submits that claim 45 is allowable.

Consequently, all pending claims are in condition for allowance and the Applicant respectfully requests allowance of all the pending claims.

### **Conclusion**

Applicant is concurrently filing this Amendment and fee calculation sheet. No additional claims fees are necessitated by the presentation of this Amendment as such fees were already paid with the prior-filed Amendment After Final on August 9, 2005. This amendment is being filed within the one-month extension period for response to a non-final office action and a request for extension of time and authorization to charge the undersigned's Deposit Account is included with the Amendment Transmittal. No additional fees are believed necessitated by the presentation of the present amendments, however, the Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Rosenbaum & Associates, P.C. deposit account No. 18-2000.

Applicant believes all requirements have been met. Should the Examiner require any further information or wish to discuss any aspect of this response, the Examiner is encouraged to telephone the undersigned at the telephone number set forth below.

Respectfully submitted,



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